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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,589	04/30/2001	Dale F. McIntyre	82466RLO	2441

7590

04/13/2004

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EXAMINER
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CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

22

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/845,589

Applicant(s)

MCINTYRE ET AL.

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8,10-15,17,18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8,10-15,17,18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In view of the appeal brief filed on December 22, 2003, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, line 1, "the information" lacks proper antecedent basis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over <http://film.icpenneyportraits.com> (hereafter referred to as FJCP) in view of Monn (5,712,005).

FJCP discloses a method of arranging a series of at least two visual images of different characteristics of the same image comprising using a photographic digital image to produce a series of digital images of the same image where the images have different characteristics as specified by the user; the images are formed on a single photographic print medium and can be manually cut out from the medium. FJCP further discloses the ability to provide the print mediums with indicia (i.e., "Happy Easter", "Please Come", "You're Invited", etc.). Inherently, this would include providing instructions on the print medium since it would only depend on the intended use of the assembly and the desired information to be displayed. It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of print medium does not alter the functional relationship. Mere support by the substrate

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for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

FJCP discloses the claimed invention except for explicitly disclosing manually fixing the cut out visual images on a page to form a composite image which can be used in a scrapbook. It is well-known in the art to cut out digital images for scrapbooking purposes. Monn discloses a kit for decorating a photo album storage box wherein the edges of a photocopy of a photograph are torn according to an enclosed instruction sheet (20) (as seen in figures 1 and 2). Adhesive is then applied to the back side of the photocopy such that the photocopy can be applied to box to provide a collage of torn photocopies (see col. 4, lines 18-52). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the images of the print medium of FJCP to be cut out and fixed to a surface in a scrapbook, as taught by Monn, to provide the images in a book in a manner which is aesthetically pleasing to the user.

Regarding claim 3, FJCP, as modified by Monn, discloses the characteristics including different sizes.

Regarding claim 4, see the above rejections to claim 1.

Regarding claim 6, FJCP, as modified by Monn, discloses the cut out images being fixed by using an adhesive as set forth above.

Regarding claim 8, FJCP, as modified by Monn, discloses the method of making a scrapbook page as set forth in the rejections to claim 1. Further, FJCP, as modified by

Monn, discloses providing a collection of pictures to create a collage (this would provide a page annotated with other pictures).

Regarding claims 10 and 11, see the above rejections to claim 1.

Regarding claim 12, FJCP, as modified by Monn, discloses the visual images being photographic images.

Regarding claim 13, FJCP, as modified by Monn, discloses the characteristics including different sizes.

Regarding claim 14, FJCP, as modified by Monn, discloses providing other visual images after fixing the visual image (see Monn, col. 4, lines 38-52).

Regarding claim 15, see the above rejections to claim 1.

Regarding claim 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claim 18 and 23-25, see the above rejections to claim 1.

6. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over FJCP in view of Monn, as used above, and further in view of Morag ('545).

FJCP, as modified by Monn, discloses the claimed invention except for sending a digital image over a communication channel to a service provider with instructions to the service provider.

Morag discloses a method of generating a personalized photo album comprising using digital images transmitted over a service provider. The images and instructions are transmitted by digital means such as over the Internet. The service provider prints the images on a single sheet of paper. Once the album is complete, an electronic proof copy may be sent to the customer for approval having computer-readable instructions for viewing and/or printing of the album. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify FJCP's invention to include instructions, as taught by Morag, for providing information related to the album between the customer and the service provider.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 20-25 have been considered but are moot in view of the new ground(s) of rejection.


**Conclusion**


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 6, 2004

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**

  
**A. L. WELLINGTON**  
**SUPERVISORY PATENT EXAMINER**  
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